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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,256	03/01/2002	Kishan Khemani	11527.354	4244

22913 7590 02/24/2005

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EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/087,256

Applicant(s)

KHEMANI, KISHAN

Examiner

Ana L. Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/6/2004
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-26 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1, 3, 7-12 and 18-26 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7-12 and 18-26 is/are rejected.
- 7) ☐ Claim(s)        is/are objected to.
- 8) ☐ Claim(s)        are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on        is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No.       .
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date       .
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date.       .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:       .

## DETAILED ACTION

### *Election/Restrictions*

1. During a telephone conversation with Mr. John M. Guynn on February 8, 2005 a provisional election was made with traverse to prosecute the invention comprising polyethylene terephthalates modified by replacing a portion of terephthalate groups with aliphatic diacid ester groups as the ultimate species of stiff polymer and aliphatic polyester as the ultimate species of soft polymer, claims 1, 3, 7-12 and 14-26. Affirmation of this election must be made by applicant in replying to this Office action.
2. Claims 4-6 and 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 24, 2004.

### *Claim Rejections - 35 USC § 112*

3. Claims 1, 3, 7-12, 14-19 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, the language “selected from the group *comprising*” constitutes improper Markush group format.

In claim 1, line 10, “terpolymers including units form from glycolide, lactide and ε-caprolactone” is indefinite since it is unclear as to whether or not the terpolymers must include units from each of the recited monomers.

In claim 1, line 10, “units form from” is confusing.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 7-12 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,096,809 (Lorcks et al).

Lorcks et al disclose films derived from biologically degradable compositions comprising at least one starch biopolymer and a polymer selected from the following materials: an aromatic polyester, a polyester-copolymer with both aliphatic and aromatic blocks, a polyesteramide, a polyglycol, a polyester urethane and mixtures of these components. In Table 1, examples 2 and 4, patentees disclose compositions comprising inter alia, polyesteramide (BAK 1095) or copolyester of aliphatic diol and aliphatic/aromatic dicarboxylic acids (BASF ZK 242/108), each reading on the presently claimed stiff polymer, and polycaprolactone, reading on the

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presently claimed soft polymer. BAK 1095 and BASF copolymers are disclosed by applicants as suitable stiff polymers for the present invention.

The composition of the reference meets the requirements of the present claims in terms of the types of materials added and their contents and, as such, would be expected to meet all the characteristics governing the presently claimed composition. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

7. Claims 1, 3, 7-12 and 14-26 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,573,340 (Khemani et al).

Khemani et al disclose biodegradable polymer blends comprising at least one stiff polymer and at least one soft polymer. The disclosure of the reference meets the requirements of the present claims both in terms of the types of materials added and their contents.

***Claim Rejections - 35 USC § 103***

8. Claims 14-19, 20-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,096,809 (Lorcks et al) described hereinabove in view of U.S. 5,817,721 (Warzelhan et al).

The further addition of organic fillers is taught by Lorcks et al at column 4, lines 32-34 and Table 3, thus rendering obvious applicants' use of organic fillers (per claims 14, 19-22). As to the addition of inorganic fillers (per claims 15-18), it is reasonably believed that while Lorcks et al do not expressly disclose the addition of such, that their addition, for their expected additive effect, would have been obvious to one having ordinary skill in the art. In this regard, attention is directed to Warzelhan et al's teaching of adding up to 80% by weight of conventional

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inorganic fillers to similar-such biodegradable compositions. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the requirement of additional inorganic fillers.

With respect to the amount of amount of starch required by claim 23, it should be noted that the starch content in the Lorcks et al composition can be can be varied, i.e., as low as 10% by weight of the overall weight, depending on the intended use of the polymer mixture. Accordingly, it would have been obvious to one having ordinary skill in the art to have employed lower amounts of starch than those exemplified with the reasonable expectation of success, in accordance with the desired intended use. Since the exemplified compositions of the reference do not add any additional plasticizers, claim 24 is considered met by the reference. It is noted that the plasticizers shown in the tables pertain to those that are used to prepare the thermoplastic starch.

As to claim 26, it would have been obvious to one having ordinary skill the art to have substituted an aliphatic polyester, such as polyethylene succinate, for the polycaprolactone component since they are taught by patentees as suitable alternatives of each other (column 4, line 65 – column 5, line 10).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 3, 7-12 and 14-26 are rejected under the judicially created doctrine of double patenting over claims of U. S. Patent No. 6,573. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain overlapping subject matter.

***Response to Amendment***

11. Applicant's amendments filed December 06, 2004 have effectively overcome the 35 U.S.C. 102/103 rejections of present claims 1, 3, 7-12, 14-19 and 26 based on the disclosures of Sinclair et al '642 and Tsai et al.

***Response to Arguments***

12. 35 U.S.C. 103 rejections over 35 Sinclair 35 al '642 and Tsai et al are being held in abeyance until such time that applicants' elected species embodiments are found allowable. It is maintained that said cited references would be pertinent to generic claims 20-25.

***Prior Art***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zhang et al discloses blends of Biomax and polycaprolactone (column 9, lines 50-60).

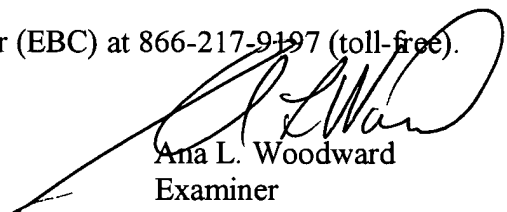
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***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward  
Examiner  
Art Unit 1711

AW